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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 18

Application Number: 07/715258  
Filing Date: June 14, 1991  
Appellants: James B. Williams et al.

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Gary B. Cohen

For Appellants

**EXAMINER'S ANSWER**

This is in response to Appellants' brief on appeal filed July 23, 1998.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claim***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendment After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is deficient because whether the broken line drawing amendment is proper is what is at issue. The claimed design is directed to an icon for a computer display.

**(6) *Issues***

The Appellants' statement of the issues in the brief is substantially correct. Appellants' amendment of "May 21, 1993" was received on May 24, 1993 by the Patent Office.

**(7) *Grouping of Claims***

Since there is only a single claim in a design patent application, the grouping of claims is not applicable.

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**(8) *Claim Appealed***

The copy of the appealed claim contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claim under appeal.

**(10) *New Prior Art***

No new prior art has been applied in this examiner's answer.

**(11) *Response to argument***

**Rejection under 35 U.S.C. 112, first paragraph**

The issue of whether or not computer generated icons are statutory subject matter under 35 U.S.C. 171 is the subject of the Guidelines for Examination of Design Patent Applications for Computer-Generated Icons (Guidelines), 1185 O.G. 60 (April 16, 1996). These Guidelines define the Office's policy toward this subject matter, and relies heavily on the Board of Patent Appeals and Interferences' decision in Ex parte Strijland, 26 U.S.P.Q.2d 1259 (BdPatApp & Inter 1992) for guidance.

In short, the Guidelines require that a computer-generated icon be embodied in an article of manufacture to qualify as statutory subject matter under 35 U.S.C. 171. The "embodied" language is critical because it distinguishes between a computer-generated icon per se, and one that is embodied in an underlying article of manufacture. In the Strijland decision, the Board clearly reaffirmed that "a picture standing alone is not protectable by a design patent," and that

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“PTO regulations expressly require that the design must be shown applied to an article.” 26  
U.S.P.Q.2d 1259, 1262.

The Guidelines further set forth requirements which were discussed in the Strijland case, namely, that the title must be directed to statutory subject matter, and that the drawing disclosure must show the underlying article of manufacture.

In an attempt to comply with the Guidelines, Appellants submitted a proposed drawing on May 24, 1993 which added broken line disclosure in the form of rectangles around the icons shown in the three figure views. This broken line disclosure is intended to represent a computer display. The subsequent addition was deemed new matter, and a rejection of the claim under 35 U.S.C. 112, first paragraph was applied.

In response, Appellants assert that their original disclosure contains support sufficient for the addition of the broken line representation of a computer display. They also assert that the addition of the broken line disclosure was for clarification and uniformity. They note that the words “computer display” in the title and throughout the specification are sufficient bases for the added broken line disclosure. They provide as support dictionary definitions of “computer” and “display,” patent literature at the time of filing of the instant application, and an on-line database search to show that the meanings of these words are understood by those skilled in the art and laypersons alike.

While these arguments are acknowledged, they miss the criticalness of proper disclosure in design patent applications under 35 U.S.C. 112. The claim in a design patent application,

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although in the form of words, is described in the drawing. The drawing is critical, much more so than in a utility patent application, because the drawing essentially, is the claim. Any additions or amendments must be scrutinized because changing the drawing is akin to changing the claim. In this application, Appellants assert that the words "computer display" are sufficient to support rectangular broken line disclosures as shown in the subsequently filed proposed drawing.

However, the examiner disagrees that this is sufficient basis because the words "computer display," do not elicit the single, specific, visual representation shown in the subsequent drawing amendment. A "computer display" could mean a multiplicity of visual representations -- a three dimensional computer monitor, a display on a photocopier, a display on a dashboard of an automobile, a display on an automatic teller machine, a narrow display screen, a large display screen, a circular screen, a curved screen, etc.... Relative to the broken line disclosure, the icon could be located in the center, in the upper left hand corner, in the lower right hand corner, in the center on the left, in the center but slightly to the right. The possibilities are numerous. The point of this laundry list is to show that "computer display," by itself, cannot be relied upon as a basis for the added drawing of approximately 1 ½" by 2" horizontally oriented rectangles centered around Figs. 1-2 and the 3" by 4" horizontally oriented rectangle centered around Fig. 3.

As evidenced by the discussion above, the term "computer display" in the specification has not been ignored. The words are simply not a sufficient basis to support the specific broken line disclosure which was subsequently added because a multitude of "computer displays" could be envisioned. The subsequently added broken line disclosure clearly adds new matter to the

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disclosure because the specific visual representation is not described in the original disclosure to the extent necessary for one of ordinary skill in the art to make or use the same.

An example by analogy may bring light to the situation. If a claim in a design patent application was directed to a “car,” and no drawing was submitted in the original disclosure, subsequent submission of a drawing showing a two-door hatchback clearly would constitute new matter. Although the word “car” is a common basic word known to English language speakers, a single specific visual representation of a “car” will not be common to all persons who understand the word -- it could bring to mind a recreational vehicle, a dune buggy, a station wagon, a sports coupe, a toy car, a minivan, etc.... The issue is not whether the subsequent broken line disclosure contradicts the original disclosure, the issue is whether that specific visual representation is clearly supported from the original disclosure.

Appellants assert that the Office, by classifying applications for icons in D18 relating to “printing and office machinery,” clearly understood the nature of computer-generated icons. The Office understands the relationship of icons to computers. Of course computer-generated icons relate to computers. In the late eighties and early nineties, it was precisely whether computer-generated icons, at that time a new technology, could be considered statutory subject matter which was the subject of years of policy discussion and formulation which finally resulted in the published Guidelines in 1996.

Problems under 35 U.S.C. 112 arise when written descriptions in the specification are relied upon to support a drawing feature or structure which was not originally shown in the

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drawing. Unless the written description is so specific that a person of ordinary skill in the art could understand the details, specific dimensions, and characteristics of the ornamental design, a written description usually will not be sufficiently descriptive due to the usually complex nature of design patent drawings. In this application, had the original written description been in a form similar to an above paragraph where the exact lengths of the broken lines and the exact position of the icons relative to the broken line drawings were described, then a new matter rejection of the claim may have been avoided. In the “car” analogy, a written description would have to be so specific that the exact shape of the car and its individual components (e.g. headlights, bumpers, door handles, etc...) could be reproduced, i.e. a written blueprint of sorts.

Appellants’ response to this argument is that there is no requirement in the laws or rules to be so specific about the size of a broken line drawing. Again, this misses the point. No written description other than simple figure descriptions are required at all when there is a clear, complete, and consistent drawing. In the present situation, Appellants are relying on written description to fill the absence of drawing. When forced to rely on words for what is absent in the drawing, appellants are bound by 35 U.S.C. 112, which requires specific and detailed written descriptions. Since there is nothing “conventional” about a “computer display,” as explained above, the leap from those words to the subsequent additional drawing disclosure is considered new matter.

Appellants further assert that under 37 C.F.R. 1.117, the drawing can be amended to conform to the specification. However, the situation here does not present a mere inaccuracy or



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minor inconsistency. Appellants have as introduced new matter because the broken line rectangles representing displays adds to the drawing without basis in either the original drawing or specification. New matter, whether in the form of broken or solid line disclosure carries the same significance. In the case of the present application, broken line disclosure has a critical role because its existence determines whether or not there is patentable subject matter under 35 U.S.C. 171.

Contrary to another of Appellants' assertions, refusal to accept the amended drawing is not only completely consistent with current Office standards, but is also required by them. Although broken line disclosure is unclaimed subject matter, it does not follow that it is conventional or irrelevant. Not uncommonly, the manner in which a design is claimed may be dictated by other than what is new or patentable. Other issues, such as scope or infringement, may come into play. In the case of computer-generated icons, the broken line disclosure serves an important dual purpose: first, it illustrates environment, and second, it is the underlying article of manufacture which propels the computer-generated icon into the realm of statutory subject matter. When Appellants state that the "[p]aper [t]ray [i]con design is the invention of the present application, not the particular shape or structure of a known computer display with which the icon is displayed," care must be exercised. The icon is inextricably connected to the underlying article of manufacture because without it, there is no statutory subject matter. As a reminder, computer-generated icons, per se, are akin to images, both of which are nonstatutory subject matter under 171.

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Note that Appellants' own comment in the Appeal Brief raises doubt as to whether there is solid basis in the original disclosure for the subsequent broken line drawings. By stating that the "computer display article...is not intended to be limited to a screen of any particular shape or size," they further confuse what exactly is being disclosed. Appellants argue on the one hand that the subsequently added broken line disclosure is fully supported in the original specification, then on the other hand, Appellants argue that the computer display portion is not meant to be any particular shape or size. The specification must be "full, clear, concise and exact," to borrow the words from 35 U.S.C. 112, first paragraph.

Appellants cite In re Zahn, 204 U.S.P.Q. 988 (CCPA 1980) to support the notion that the broken line drawing is only meant for environmental or background purposes, and therefore need not be specific. The decision in Zahn, however, does not argue against the new matter rejection set forth in this application. The issue decided in Zahn was that a design for a portion of an article could be claimed subject matter, and that a unitary, complete article was not necessary under 171. The specific cite on p.11 of Appellants' Appeal Brief is part of the Court's reasoning that if the inventor wanted to claim a design for a portion of an article, there was no prohibition against so doing. Broken line disclosure in that case was used to show the remainder of the unitary article. How Appellants apply Zahn to support withdrawal of the new matter rejection is not clear because the Court did not specifically speak to the addition of broken line disclosure.

Appellants continue by arguing that the Office Guidelines themselves mandate that the examiner permit the subsequent proposed drawing amendment because at a minimum, there is

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“suggestion” in the original disclosure. If there were sufficient basis for inclusion of the subsequent amended drawing, the examiner would not hesitate to do so. The reason the examiner has not made a suggestion which would bring the claim into compliance is because the claim may be fatally defective. Appellants were forewarned in the Office Action mailed February 4, 1997, paragraph 7 that it might not be possible to amend the application without introducing new matter. This is the case presented here. Unfortunately, Appellants encountered a situation where the final Guidelines were published during the lifetime of the instant application and nearly five years after its filing date. Although Appellants are making an honest effort to comply with the later established Office policy, correcting the original disclosure without introducing new matter is simply not a possibility in view of the existing law and new Guidelines.

To allow inclusion of the proposed drawing without sufficient basis is not only contrary to existing law, but also begins a slippery slope toward the eventual dismantling of disclosure requirements under 35 U.S.C. 112 for design patent applications. If broad inference is permitted from written descriptions to drawings is permitted, then an inventor in a future application may merely state a word “telephone,” or “shoe,” or chair,” in the original specification, and any subsequent amendment showing any configuration of a telephone, shoe or chair would be acceptable because these are commonly known, basic English words. Never mind that these examples of common articles constitute respectively, thirteen (13), seventy-nine (79), and forty-seven (47) subclasses worth of design patents. New matter will become acceptable instead of remaining legally prohibited.

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Rejection under 35 U.S.C. 171

The rejection of the claim under 35 U.S.C. 171 as non-statutory subject matter is maintained since the inclusion of the broken line disclosure is considered new matter. Without the broken line disclosure, the claim is directed to an icon, per se, which is non-statutory subject matter under 171.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

**M. H. TUNG**  
**PRIMARY EXAMINER**  
**ART UNIT 2901**

mht  
September 22, 1998

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